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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,781	12/02/2003	Jin-Woong Kim	678-1097 (P10649)	3826
28249	7590	09/09/2005	EXAMINER	
DILWORTH & BARRESE, LLP 333 EARLE OVINGTON BLVD. UNIONDALE, NY 11553			STEIN, JULIE E	
			ART UNIT	PAPER NUMBER
			2685	

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/725,781

Applicant(s)

KIM ET AL.

Examiner

Julie E. Stein, Esq.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

2. Figures 1 and 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities: In the Brief Description of the Drawings, Figures 1 and 2 appear to show only what is known, therefore they should indicate that they are prior art.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claims 4 and 5 recite the limitation "steps" in the preamble. There is insufficient antecedent basis for this limitation in the claim, as the claims recite a communication system and a communication device respectively.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1 and 4-5 are rejected under 35 U.S.C. 102(e) as being anticipated by WO 01/33782 A1 to Nokia.

Nokia discloses all the steps of independent claim 1, including a method for transmitting and receiving a multimedia message in a mobile communication system (abstract), the method comprising the steps of: receiving summarized information on a plurality of data types included in the multimedia message from the mobile communication system (page 8, line 25 to page 9, line 20) and providing the received summarized data type information (page 9, lines 20 to 25); requesting multimedia data corresponding to at least one of a data type according to a user selection (page 12,

lines 18 to 38); and receiving the multimedia data in response to the request (page 13, line 31 to page 16, line 9).

The rejection of claim 1 is hereby incorporated. Nokia discloses all the elements/steps of independent claim 4, including a mobile communication system (abstract) for transmitting and receiving a multimedia message (abstract), comprising the steps of: producing and transmitting summarized information on a plurality of data types included in the multimedia message (page 8, line 25 to page 9, line 20); and transmitting the multimedia data in response to a request for multimedia data (page 13, line 31 to page 16, line 9).

The rejections of claims 1 and 4 are hereby incorporated. Nokia discloses all the elements/steps of independent claim 5, including a mobile communication device (Figure 2, MS) in a mobile communication system (abstract) for transmitting and receiving a multimedia message (abstract), comprising the step of requesting a desired type of data type based on received summarized information of a multimedia message (page 13, line 31 to page 16, line 9).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claim 2 is rejected under 35 U.S.C. 103(a) as being obvious over Nokia in view of U.S. Patent Application Publication No. 2002/0116465 A1 to Kim et al.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

The rejections of claims 1 and 4-5 are hereby incorporated. Nokia teaches all the steps of independent claim 2, including a method for transmitting and receiving a multimedia message in a mobile communication system (see above), the method comprising the steps of: receiving in the mobile communication system a multimedia message including a plurality of data types from a terminal (Figures 2 and 4); storing the received multimedia message while separately storing the data types (page 8, lines 25 to 30); producing summarized multimedia information, which includes information on a kind of each of the data types and a number of each kind of data types (see above); transmitting the summarized multimedia information in a signal receipt notification message (page 8, lines 31 to 39); upon receiving the signal receipt notification message in a terminal, providing the signal receipt notification message to a user (Figure 2), and requesting multimedia data corresponding to a data type selected by the user (Figure 2, GET message); and transmitting the corresponding multimedia data from the mobile communication system to the terminal in response to the request from the terminal (Figure 2, Multimedia message).

However, Nokia does not specifically teach the extra steps of transmitting a response message (to the signal receipt notification message) according to a selection by the user; upon receipt of the response message by the mobile communication system, producing and transmitting multimedia information; upon receiving the multimedia information by the terminal, providing the multimedia information to the user (to which the user then selects corresponding data, as above). But, Kim teaches a method of appending a URL to a multimedia email to indicate that there is further

multimedia content that may be accessed through the URL and that a user may select a VOD service through a menu item on the phone to connect to the multimedia content on the VOD server via the URL after choosing to view the multimedia email. See paragraphs 21, 24, and 27-28. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify Nokia to include the functionality of Kim, such as the ability of the user to receive part of the multimedia message (the email) and then to further select to receive the rest of the multimedia message in view of the limited local memory of portable terminals and the size of many multimedia files. See Kim, paragraph 7.

12. Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim in view of Nokia.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer

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in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

The rejections of claims 1-2 and 4-5 are hereby incorporated. Kim teaches all the elements of independent claim 3, including a mobile communication system for transmitting and receiving a multimedia message (see abstract), the system comprising: an LME (Figure 1, element 108, the VOD server) for receiving a multimedia message including a plurality of data types from a first terminal (paragraphs 21-22, email and multimedia data), storing the received multimedia message while separately storing the data types (paragraph 22, in the VOD server and Email server), transmitting basic data type information (paragraph 27, the SMS indicating email and the URL) and, upon receiving a request for multimedia data from a second terminal, transmitting multimedia data of a data type corresponding to the request (paragraphs 27-28, the email); and an LMSC (Figure 1, element 110, the email server) for producing and transmitting summarized multimedia information (paragraph 23, the email with the URL), upon receiving a response message from the second terminal (paragraphs 24-25, user requests email), producing and transmitting multimedia information (paragraphs 26-27, access via POP3 to email), and transmitting the request for multimedia data from the second terminal to the LME (paragraphs 27-28, user selects VOD service); wherein the second terminal transmits a corresponding response message upon receipt of the summarized multimedia information (paragraph 24, see above), receives the multimedia

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information (paragraph 27, see above), and requests multimedia data corresponding to a data type selected by a user (paragraphs 27-28, the multimedia message).

However, Kim does not explicitly teach that the LMSC includes summarized multimedia information including information of a kind of each of the data types and a number of each kind of data types. However, Nokia teaches that one way of summarizing the multimedia message is to include a count of the type and number of each component of the multimedia message. See page 8, line 31 to page 9, line 20. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify Kim in order to include the added functionality of including the added information as taught by Nokia, in the SMS message indicating that an email had arrived as taught by Kim in paragraph 24, because it aids the user in decision making as to the retrieval of the multimedia message. See Nokia, page 10, lines 25 to 30.

The rejections of claim 1-5 are hereby incorporated. Kim in view of Nokia teaches all the steps of independent claim 6, including a method for transmitting and receiving a multimedia message in a mobile communication system (see above), the method comprising the steps of: receiving a multimedia message including a plurality of data types from a terminal (see above), storing the received multimedia message while separately storing the data types (see above), and transmitting basic data type information, in an LME (see above); producing summarized multimedia information, which includes information of a kind of each of the data types and a number of each kind of data types, in an LMSC (see above); transmitting a signal receipt notification

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message which includes the summarized multimedia information, in an SMSC (Kim, Figure 1, element 118 and paragraph 24); and receiving the signal receipt notification message (see above), providing the summarized multimedia information to a user (see above), and transmitting a response message according to a selection by the user, in a receiving terminal (see above); wherein the LMSC produces multimedia information, upon receipt of the response message (see above); wherein the receiving terminal receives multimedia information, provides the multimedia information to the user, and request multimedia data corresponding to a data type selected by the user (see above); wherein the LMSC receives the corresponding multimedia data from the LME in response to the request, and transmits the corresponding multimedia data to the receiving terminal (Kim paragraph 27).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie E. Stein, Esq. whose telephone number is (571) 272-7897. The examiner can normally be reached on M-F (8:30 am-5:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on (571) 272-7899. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JES

Nguyen Vo
8-31-2005

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PRIMARY EXAMINER